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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,731	07/30/1999	RONALD A. KATZ	244/165	9809

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EXAMINER	
WOO, STELLA L	

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 07/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/364,731	Applicant(s) KATZ, RONALD A.	
	Examiner Stella L. Woo	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29,33,35-39,43 and 45-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29,33,35-39,43 and 45-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29, 33, 35-39, 43, 45-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Independent claims 29, 38-39 and 48 recite "said switching computer means capable of disallowing completion of a call through the switching station if determined from processing of **call data and additional parameter** by the switching computer means that the call is not placed by a caller in good standing" (claim 29, lines 20-23; claim 39, lines 20-23) and "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing" (claim 38, lines 14-15; claim 48, lines 14-15), "said call data including automatic number identification and a personal identification number" (claim 29, lines 8-9; claim 38, lines 7-8; claim 39, lines 8-9; claim 48, lines 7-8) and the additional parameter being "at least one parameter relating to the card" (claim 29, lines 14-15; claim 38, lines 10-11) or the additional parameter being "at least one parameter relating to the identification data" (claim 39, lines 14-15; claim 48, lines 10-11).

Applicant's specification does not provide support for a using a caller's automatic number identification **and a personal identification number** and a parameter relating to the card (or identification data) for determining whether the caller is in good standing, as recited in the independent claims 29, 38, 39, and 48.

Moreover, according to Newton's Telecom Dictionary, within the telephony art, a personal identification number is "an AT&T term meaning the last four digits of your AT&T, MCI Bell operating company Credit Card – the card you use for making long distance numbers." Applicant's specification includes no mention of a personal identification number as defined within the telephony art.

In addition, Applicant's system does not **prevent connection** if it is determined that the caller is not in good standing, as recited in claims 31 and 39, since connection has already taken place between the caller and the call destination prior to receiving lottery information from the caller.

Applicant's disclosure fails to provide support for "a voice response means capable of providing an oral report of current account status to travel card users" (claims 33 and 43).

Response to Arguments

3. The claims of this application are asserted by applicant "to interfere with the substance of the Marshall patent '891." However, it is not U.S. Pat. No. 5,068,891 with which interference was originally sought by Applicant, but rather U.S. Pat. No. 5,790,636. It is assumed that applicant's remarks are directed to U.S. Patent No. 5,790,636 by Marshall, not U.S. Pat. No. 5,068,891.

The examiner does not consider Applicant's claims to be directed to the same invention as that of U.S. Patent No. 5,790,636 because it does not contain all the material limitations of the patent claims as required by 35 USC 135 (b), namely, the use of **travel cards** for controlling the telephone system. Accordingly, an interference cannot be initiated based upon the presented claims. Applicant has argued that the "Marshall '636 patent specification merely mentions a 'travel card' which functions to support credit transactions." However, in US Pat. No. 5,790,636 (col. 1, lines 15-60) Marshall describes his '636 invention as an improvement upon his prior invention (US Pat. No. 5,068,891). This Marshall patent '891 clearly defines a travel card as a telephone credit card which enables a caller to place long distance calls over any phone and to charge the call to the account of the cardholder (col. 1, lines 5-19).

Applicant argues that "the form of the card or ticket is not considered to be relevant." However, Applicant's argument is not persuasive since a travel card has an art-accepted meaning in telephony. Newton's Telecom Dictionary defines a travel card as follows:

***Travel Card**: Another name for a telephone credit calling card. Travel card calls that are placed against a travel card number issued by the service provider, typically a phone company. As each call is completed, the long distance switch increases that card's account balance by the amount of each call. During the processing of a call, if the travel card is invalid or if the caller does not respond to a system prompt, the serving switch will typically ask the caller to hold the line for a live operator, and transfers the call to an Operator Workstation. When the operator answers, the OWS screen shows call information, including card number (if already entered), destination number (if already entered), trunk identification, and a failure code.*

There is no supporting disclosure for the use of a travel card as defined within the telephony art, that is, a telephone credit calling card which is issued by a service provider and enables a caller to place long distance calls over any phone and to charge the call to the card's account. Since the body of the claims depend on the preamble for completeness and the term "travel card" has a specific meaning in the telephony art, the term 'travel card" should be given patentable weight.

Based on both the art-accepted definition of the term "travel card" and Marshall's own definition of the term as it applies to his invention, which matches the Telecom Dictionary's definition, the credit card of Applicant's disclosure cannot be considered as a travel card. Applicant's disclosure specifically describes a mail order transaction system in which a caller can order merchandise using a credit card (page 21, line 19 – page 22, line 2). In contrast, a travel card enables a caller to place a long distance call over any phone and to charge the call to the cardholder's account. Applicant's credit card is used to purchase merchandise and, clearly, cannot be considered as a travel card used for placing a long distance call, as defined in the art.

Applicant's claim 29 further differs from claim 1 of the Marshall patent in that it includes the additional limitation of "being" on line 14 of claim 29.

In the amendment filed December 26, 2002, Applicant argues that several form of identification are disclosed in the specification which might be treated as a personal identification number, namely, a credit card number (page 22, line 22), a customer number (p. 22, line 21), a personal identification number (page 33, line 9), a key number (page 35, line 20 or a driver's license number (page 37, line 15). However, Applicant's argument is not persuasive. According to Newton's Telecom Dictionary, within the telephony art, a personal identification

number is "an AT&T term meaning the last four digits of your AT&T, MCI Bell operating company Credit Card – the card you use for making long distance numbers." A customer number, a key number, a driver's license number or credit card number cannot be considered as a personal identification number, which has a particular meaning within the telephony art. The personal identification number in Applicant's page 33, line 9 refers to a child's qualifying identification data which allows the child to participate in a television game show (page 33, lines 5-10). This operating format does not include the use of data related to cards or an additional parameter related to the card or additional data related to the identification data.

In the amendment filed December 26, 2002, Applicant points to page 9, line 9 and page 12, line 30 as providing support for the oral report of current account status. However, these citations merely refer to a voice cue. There is no description of any oral report of current account status.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stella L. Woo
Primary Examiner
Art Unit 2643